

## REMARKS

Applicants respectfully request reconsideration of the application.

### *Office Action Summary*

The specification has been objected to under MPEP 608.01 and MPEP 2173 as not providing support for the claimed subject matter of claims 5, 9 and 13.

Claim 13 has been objected to for an informality.

Claims 5-12 have been rejected under 35 USC § 101 as being directed to non-statutory subject matter.

Claims 1-4 and 13-17 have been allowed. Accordingly, the following remarks are directed only to the rejected claims

### *Status of Claims*

Claims 1-17 are pending in the application. Claim 5 has been amended as to form and to more clearly recite an existing limitation. Claim 13 has been amended to correct an informality. No claims have been added or canceled.

Applicants reserve all rights with respect to the applicability of the doctrine of equivalents.

### *Examiner Interview Summary*

Applicants thank the Examiner for the courtesy of a telephone interview on June 18, 2007 with applicants' representative Richard W. Thill (Reg. No. 53,686). The interview was requested by the applicants in view of recent clarifications to the Interim Guidelines for Examination of Patent Applications for Subject Matter eligibility, issued

by the Deputy Director for Patent Examination Policy after the mailing date of the present Office Action. The interview was directed to both 35 USC § 101 and § 112 issues.

During the interview, the Examiner confirmed that under the clarified guidelines, a claimed invention is a practical application of an abstract idea, and therefore statutory, if the claim recites a useful, concrete and tangible result without reciting the uses to which the result is ultimately put. The utility of the invention may be found in the specification. Additionally, terms in the claims such as “receiving,” “generating,” “determining” and the like, are sufficient to establish a tangible result.

Claim 5 was discussed with respect to finding support in the specification under 35 USC § 12, second paragraph. Agreement was reached on an amendment to render claim 5 allowable.

Claim 9 was discussed with respect to the requirements for a means plus function claim under 35 USC § 112, sixth paragraph. The Examiner asked that the applicants put forth their argument in a response.

### ***Claim Rejections Under 35 U.S.C. § 101***

Claims 5-12 have been rejected under 35 USC § 101 as directed to non-statutory subject matter.

#### **Claims 5-8**

With respect to claim 5, the Office Action states:

The claimed “article” and “storage medium” fail to fall with one of four statutory categories of invention, process, machine, manufacture and composition, since it fails to produce a useful result.

Furthermore, the claim lacks the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor a composition of matter. As such, the claim fails to fall within a statutory category.

(3/26/07 Office Action, page 3)

As amended, claim 5 recites:

**An article of manufacture comprising:**  
**a computer readable storage medium** having instructions stored thereon, which when executed by a **computer**, cause the computer to perform a method, comprising:  
receiving an update message having a first version format; and  
generating repeatedly a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated.

(emphasis added)

Applicants submit that claim 5 is an example of a Beauregard claim, which is a well-established claim form. See *In re Beauregard*, 53 F.3d 1583 (Fed Cir. 1995) (holding as a statutory article of manufacture, a claim to a computer program embodied in a computer-readable medium that, when read by a computer, causes the computer to perform a method).

On its face, claim 5 claims “an article of manufacture,” which is a statutory “manufacture” under 35 USC § 101. As recited in claim 5, the article of manufacture comprises a “computer readable storage medium.” This element of claim 5 is supported by the disclosure at least at page 10, lines 13-22.

Additionally, claim 5 recites “a computer,” which applicants submit is a machine. This element is supported by the disclosure at least in Figure 3 and at page 11, line 1 wherein “processor 108” is disclosed. Applicants respectfully remind the

Examiner that “[t]he subject matter of the claim[s] need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement.” MPEP 2163.02. Further, in contrast to the characterization of the Office Action, the operations of “receiving” and “generating” are clearly steps or acts.

The Office Action states that the claimed article of manufacture is not statutory because it does not produce a useful result. Applicants submit that, as agreed during the Examiner interview cited above, the standard for “utility” put forth in the Office Action does not represent the present position of the USPTO, based on a memorandum issued by the Deputy Commissioner for Patent Examination Policy, dated April 12, 2007. In that memorandum, the Deputy commissioner states:

Certain inconsistencies have come to my attention in the application of the Interim Guidelines for Examination of Patent Applications for Subject Matter Eligibility, which are set forth in section 2106 of the Manual of Patent Examining Procedure (8<sup>th</sup> Ed. Rev. 5, Aug. 2006). The situation arises in the context of whether or not a claim is for a practical application of an abstract idea, law of nature, or natural phenomenon.

...

A practical application in this context can be the result itself, and does not require that steps or additional limitations be added to the claim. As states in *state Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1956, 1601 (Fed. cir. 1998):

Today, we hold that the transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces “a useful, concrete and tangible result”—a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades.

It is the result that should be the focus. If the result has a real world practical application/use, then the test has been satisfied. **The claim**

**need not include the uses to which the result is ultimately put, just the result itself.**

Another area of inconsistency surrounds the use of the terms such as “determining,” “calculating,” and similar expressions. Some object to these as not creating a tangible result. *See, e.g., State Street*, 149 F.3d at 1375, 47 USPQ2d at 1602 (holding the calculation of a number having a real world value to be a “useful, concrete, and tangible result”) and *AT&T v. Excel Communications, Inc.*, 172 F.3d 1352, 50 USPQ2d 1447 (Fed. Cir. 1999) (holding a method claim including the generation of a message record for an interexchange call to be statutory). The specification should be referred to for a meaning of the terms. *See In re Musgrave*, 431 F.2d 882, 893, 167 USPQ 280, 289 (CCPA, 1970) (“[W]e cannot agree with the board that these claims (all the steps of which can be carried out by the disclosed apparatus) are directed to non-statutory processes merely because some or all of the steps therein can also be carried out in or with the aid of the human mind or because it may be necessary for one performing the process to think. . . .”).

Memorandum from John J. Love, Deputy Commissioner for Patent Examination Policy, USPTO (Apr. 12, 2007) (emphasis added)

In view of the stated position of the USPTO and the supporting case law, applicants submit that claim 5 recites statutory subject matter at least because 1) the terms “receiving” and “generating” in claim 5 create a tangible result, and 2) the useful application of upgrading a database by release chaining is disclosed in the specification as a whole and need not be recited explicitly in the claims.

Given that claim 5 recites statutory subject matter, applicants submit that claims 6-8, which depend from claim 5, also recite statutory subject matter.

#### Claims 9-12

With respect to claim 9, the Office Action states:

The claimed “article” and “storage medium” fail to fall with[sic] one of four statutory categories of invention, process, machine, manufacture and composition, since it fails to produce a useful result.

Furthermore, the claim lacks the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor a composition of matter. As such, the claim fails to fall within a statutory category.

(3/26/07 Office Action, page 4)

Claim 9 recites:

An **apparatus** for updating a message from a first version to an upgraded version by chaining through intermediate versions comprising:

**means for receiving** an update message having a first version format; and

**means for repeatedly generating** a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated.

(emphasis added)

As a preliminary matter, claim 9 does not recite an “article” or a “storage medium.” Claim 9 recites “an apparatus.” Applicants submit that “an apparatus” has long been accepted by the USPTO as a statutory category of “machine” under 35 USC § 101.

With respect to the purported lack of utility (i.e., “it fails to produce a useful result”), applicants refer the Examiner to the citations and comments above regarding the proper interpretation of the Interim Guidelines for Examination of Patent Applications for Subject Matter Eligibility.

With respect to “the claim lack[ing] the necessary physical articles or objects to constitute a machine or manufacture within the meaning of 35 USC 101, applicants would respectfully point out that claim 9 is a means plus function claim. Under 35 USC § 112, sixth paragraph, “[a]n element in a claim for a combination **may be expressed as**

**a means or step for performing a specified function without the recital of structure, material, or acts in support thereof**, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof" (emphasis added). "A means plus function limitation is distinctly claimed if the description makes it clear that the means correspond to well-defined structure of a computer or computer component implemented in either hardware or software and its associated hardware platform." MPEP 2106 V.A.(2) (*citing Atmel Corp. v. Information Storage Devices Inc.*, 198 F.3d 1374, 1380, 53 USPQ2d 1225, 1229 (Fed. Cir. 1999); *B. Braun Medical Inc. v. Abbott Labs.*, 124 F.3d 1419, 1424, 43 USPQ2d 1896, 1899 (Fed. Cir. 1997).

Applicants submit that the "acts" recited in claim 9 (i.e., "receiving" and "repeatedly generating") are described in the specification at least at page 12, line 5 through page 16, line 5. Again, applicants remind the Examiner that "[t]he subject matter of the claim[s] need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement." MPEP 2163.02.

Applicants also submit that the written description makes it clear that the "means" corresponds to a well-defined structure of a computer at least at page 9, line 20 through page 12, line 2, in combination with Figure 1.

In view of the foregoing arguments, applicants submit that claim 9 recites statutory subject matter. Given that claims 10-12 depend from claim 9, applicants submit that claims 10-12 also recite statutory subject matter.

### ***Objections to the Specification***

The specification has been objected to as not supporting the claimed "article," "computer readable medium" of claim 5. As amended, claim 5 recites:

An article of manufacture comprising:

**a computer readable storage medium** having instructions stored thereon, which when executed by a computer, cause the computer to perform a method, comprising:

receiving an update message having a first version format; and generating repeatedly a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated.

As amended, claim 5 no longer recites a data processing system, but rather a computer. Claim 5 recites an “article of manufacture” and a “computer-readable storage medium.” Applicants have pointed out, in the comments above with respect to claim 5, that support for “computer readable storage medium can be found at least at page 10, lines 13-22 of the specification. “Computer” is supported at least at page 11, line 1 in combination with Figure 1. An “article of manufacture” comprising a “computer readable medium” finds support in the specification at least at page 12, lines 9-11 and lines 18 and 19. Again, the Examiner is respectfully reminded that “[t]he subject matter of the claim[s] need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement.” MPEP 2163.02.

The specification has been objected to as not supporting the claimed “apparatus” of claim 9. Claim 9 recites:

An apparatus for updating a message from a first version to an upgraded version by chaining through intermediate versions comprising:

**means for receiving an update message** having a first version format; and

**means for repeatedly generating a revised update message** having a next most recent version format based on the update message until a final update message having an upgraded version format is generated.

As noted above, claim 9 is a means plus function claim under 35 USC § 112, sixth paragraph. Under 35 USC § 112, sixth paragraph, “[a]n element in a claim for a

combination **may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof**” (emphasis added).

Applicants submit that the specification supports the “means for receiving...” and “means for repeatedly generating...” limitations of claim 9 at least in its description of a computer system that performs the claimed functions at page 12, line 5 through page 16, line 5 and at page 9, line 20 through page 12, line 2, in conjunction with Figure 1.

The specification has been objected to as not supporting the claimed “apparatus” of claim 13. As amended, claim 13 recites:

An apparatus for upgrading a database, comprising:  
a **network switching device** to receive an update message having a first version format; and  
a **controller card** to update a message from a first version to an upgraded version by chaining through intermediate versions, the controller card to repeatedly generate a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated.

(emphasis added)

Claim 13 recites an apparatus comprising two elements, a network switching device and a controller card. Applicants submit that a “network switching device” finds support in the specification at least at page 11, lines 5-7 (“Network switching device 110 controls the switching of data for a set of communication interface cards 112.”).

Applicants submit that a “controller card” finds support in the specification at least at page 12, lines 1-4 (“The databases in memory system 500 of controller card 575 are

updated by using update messages generated from the databases in memory system 100 of controller card 75.”)

***Conclusion***

In conclusion, applicants respectfully submit that in view of the arguments and amendments set forth herein, the applicable rejections have been overcome.

If the Examiner believes a further telephone interview would expedite the prosecution of this application, the Examiner is invited to contact Richard Thill at (408) 720-8300.

If there are any additional charges, please charge our Deposit Account No. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP



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